

REMARKS

Reconsideration and allowance of the application on the basis of the foregoing amendments, following arguments, and for other reasons, are respectfully requested.

Claims 21-42 and claims 44-51 are pending in the application. All stand rejected.

Claims 21-33, 38-42, and 44-51 were finally rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement, the Examiner alleging that 1) "The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention."; and 2) "Regarding claims 21, 28, 38, and 44, the subject matter, 'deriving its lift in flight from forces resulting from its motion through air', as now amended, is not supported by the original specification and therefore, now constitute New Matter."

Concerning the 1st allegation that "The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.", applicant contends that the allegation is not correct. In the original patent application, Ser. No. 09/313,566 filed 5/14/99, applicant stated inter alia in the paragraph entitled "1. Field of the Invention": ... "As you can clearly see in the prior art, they go through the water and they skim across the water but there has been never ever any inflatable toy that will actually get airborne, stay airborne, and you can control it in the air. ... You can actually take off behind a power boat, when you are in the water, and actually get airborne and *stay airborne* [emphasis added]. And the person or person(s) on top of this Universal Flying Hawk has a bird's eye view and with great control over flying how high and what kind of maneuvers the passenger and as long as you deem necessary. ... All the boat is doing is giving you enough lift to stay in the air. ... This is truly, without doubt, a Universal Flying Hawk that you can fly like a bird or ski behind a boat, surf the waves as a surfer may surf. You can also use this as a wake

board going through the water or a wake board as you are riding the ocean waves or going down rivers. It is very easy to put back together, clearly insert the fuselage into the wing section of the Universal Flying Hawk where the straps and/or velcro is in place - once again you have the Universal Flying Hawk - that will once again soar through the air with the greatest of ease."

In that original patent application, applicant also stated inter alia in the second paragraph of the section entitled "2. Background of the Invention": ... , but as you can clearly see with the Universal Flying Hawk it is truly a bird that flies through the wind with the greatest of ease, and it is without a doubt the safest towed water-related recreational inflatable toy that I have ever seen of the market to date. ... And if one ever wants to release for any reason whatsoever, from the power boat that is pulling them, you can simply release the clip and glide down to the water very easily and very safely."

In that original patent application, applicant also stated inter alia under item 6 of the "Figure 1" subsection of the section entitled "Claims": "Fly through the air like a kite or glider. You control how high and the movements just by shifting your weight. ... A double or triple wing can easily be attached."

In that original patent application, applicant also stated inter alia in the drawing in a notation connected by a lead line to the wing 6 of the "Figure 1": "Get air born. Stays in the air. You choose the height, and how long you stay in the air. Main body wing."

Applicant submits that the above quotes clearly show that applicant "had possession of the claimed invention". For example, claim 21 requires a rider recreational product having a wing section and a fuselage or tail section for skimming on water and flying through the air aerodynamically and separable into two sections. There can be no argument about invention possession as the disclosed product comprises a first section constituting the wing (6) of the product and deriving its lift in flight from forces resulting from its motion through air and independently usable as a rideable element, and a second

section constituting the fuselage or tail section (1) of the product and independently usable as a surfboard or ski.

Concerning the 2nd allegation that "Regarding claims 21, 28, 38, and 44, the subject matter, 'deriving its lift in flight from forces resulting from its motion through air', as now amended, is not supported by the original specification and therefore, now constitute New Matter", applicant contends that the allegation, too, is not correct. The above quotes from applicant's original patent application clearly show that applicant's product had "wings" and that the product was "airborne" and could be kept so. Now, The American Heritage Dictionary of the English Language, Published by the Dell Publishing Co., Inc., Published by arrangement with Houghton Mifflin Company, Third printing--February 1982, defines "wing" as: "3. An airfoil whose principal function is providing lift, esp. either of two such airfoils, positioned on each side of the fuselage." Applicant employs "two such airfoils, positioned on each side of the fuselage". Thus applicant submits that the subject matter, 'deriving its lift in flight from forces resulting from its motion through air', is supported by the original specification and therefore, does not constitute New Matter."

It is only necessary that the specification as originally filed convey the invention claimed clearly to those skilled in the art. The fact that the exact claim words did not appear in the specification is not controlling. In re Wright, 866 F.2nd 422, 9 USPQ2nd 1649 (Fed. Cir. 1/24/1989). It is submitted that the words "wings" and "airborne" provide sufficient antecedent basis for the claim phrase "deriving its lift in flight from forces resulting from its motion through air"; thus the phrase clearly is supported by the original specification and therefore does not constitute New Matter. A specification and claims are addressed to those who possess technical knowledge and skill in a given area, not to the public generally. Ex Parte Fahrni, 103 USPQ 193.

The same can be said for the word "aerodynamically" in claims 21, 28, 38, and 44. The American Heritage Dictionary of the English Language, *supra*, defines "aerodynamics" as "The dynamics of gases, esp. of atmospheric interactions with moving

objects." Thus it is submitted that the word "aerodynamically" is just another way of expressing the well-known physics involved in the statements like item 6 of the "Figure 1" subsection of the section entitled "Claims" of the original patent application: "Fly through the air like a kite or glider. You control how high and the movements just by shifting your weight. ... A double or triple wing can easily be attached."; and like item 1 of the "Figure 4" subsection of the section entitled "Claims" of the original patent application: "These bottom fins help control for cutting through the water or through the air in rugged or slow turns. They dig right in every time."

It is submitted that claims 21-33, 38-42, and 44-51 do not involve New Matter.

Claims 21, 38, and 44 were rejected under 35 USC 112, first paragraph, as failing to comply with the enablement requirement, the Examiner alleging that 1) "The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention."; and 2) "It is not clear how the first section constituting the wing derives its lift in flight from forces resulting from its motion through air."

As to the first allegation that "The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention", applicant urges that that is not true. As noted above, a "wing" denotes "An airfoil whose principal function is providing lift, esp. either of two such airfoils, positioned on each side of the fuselage."; and applicant employs two such airfoils, one positioned on each side of the fuselage." The original application makes clear that when the product is towed or sailing through the air like a glider, its wings provide the lifting forces which all in the art know is effected by air moving about the wing surfaces. Control is provided by the item 1 of the "Figure 4" subsection of the section entitled "Claims" of the original patent application: "These bottom fins help control for cutting through the water or through the air in rugged or slow turns. They dig right in every time."

As to the second allegation that "It is not clear how the first section constituting the wing derives its lift in flight from forces resulting from its motion through air.", applicant urges that it too is not true. As applicant noted above, a "wing" denotes an airfoil whose principal function is providing lift, and as the drawings show, applicant employs a wing in conventional fashion. When a wing moves relative to air, lifting forces, usually by the Bernoulli Effect, are generated on the wing. The phenomenon is well known. Building such a wing is well within the skill of the art. The claims comply with the enablement requirement.

Claims 21-33, 38-42, and 44-51 were "finally rejected" under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claims 21, 28, 38, and 44, the Examiner alleged that "it is not clear whether the product derives its lift in flight from forces resulting from its motion through air". Applicant urges that it is clear that the product derives its lift in flight from forces resulting from its motion through air. Claims 21, 38 and 44 state that a first section or parts "constituting the wing of the product" derives "its lift in flight from forces resulting from its motion through air". This would seem a clear statement that "the product derives its lift in flight from forces resulting from its motion through air".

Claim 28 has been amended to specify that the "thin fins ... that are upwardly when the board is attached to the recreational product for aiding control when the product is in motion through air aerodynamically", to make more clear that forces resulting from its motion through air are involved. Thus the clause structure parallels more precisely the structure of the claim preamble "A board usable as a fuselage or tail section of a recreational product for skimming on water and flying the product derives its lift in flight from forces resulting from its *motion through air* (emphasis added) aerodynamically".

Regarding claim 28, the Examiner stated that it is not clear whether the fins act as a ski when the thin fins extends upwardly from a surface of the wider rear end and acts as a surfboard when the thin fins extends longitudinally from a surface of the wider rear end". Claim 28 read: "thin fins extending upwardly when used as a ski and downwardly when used as a surfboard and longitudinally from a surface of the wider rear end and that are upwardly when the board is attached to the recreational product for aiding control when the product is in motion through air aerodynamically". The claim has been amended to read: "thin fins extending a) upwardly when the board is used as a ski and b) downwardly when the board is used as a surfboard and c) longitudinally from a surface of the wider rear end and [that] the thin fins are upwardly when the board is attached to the recreational product for aiding control when the product is in motion through air aerodynamically". The insertion of "a)" and "b)" and "c)" make more clear the portions of the claim modified by the verb form "extending"; the replacement of "that" with the noun form "the thin fins" makes more clear the subject matter of the last part of the clause. Applicant has also inserted the phrase "the board is" to eliminate any unclearness due to the previous elliptical expressions in the "a)" and "b)" portions of the clause. Applicant believes that it is now more clear that the fins extend upwardly when the board is used as a ski, and downwardly when the board is used as a surfboard; in both cases the thin fins extend longitudinally from a surface of the wider rear end; and the thin fins are upwardly when the board is attached to the recreational product for aiding control when the product is in motion through air aerodynamically".

"that (the thin fins) are upwardly when the board is attached" [to the recreational product for aiding control when the product is in motion through air aerodynamically] is not a method step, but rather a statement of the disposition of the structure in a particular combination of the board.

Regarding claims 29-32, the Examiner stated that "it is not clear how the limitation 'when the board is attached' further structurally limit the claim". Applicant urges that limitations such as "when the board is attached" do further structurally limit the claim. For example, in claim 29 it is specified that the "surface that is upwardly when the

board is attached to the recreational product" has control elements on its upper surface for engagement by the rider". Thus the claim calls for a particular structure ("control elements") in a specific physical relationship ("surface that is upwardly") in a special functional relationship ("when the board is attached to the recreational product"). Such language would seem to parallel parachute language approved in *In re Ludtke et al*, 169 USPQ 563 (CCPA 1971). See also *In re Stencel*, 828 F.2nd 751 (Fed. Cir. 1987), holding that no limitation or wording anywhere in the claim can be ignored in determining patentability.

Regarding claim 41, the Examiner stated that "it is not clear how the central longitudinal fin is connected". The claim has been amended to specify that it is connected "on the underside of the first section".

Claims 21-32, 34-36, 38-42, and 44-51 were rejected under 35 USC 102(e) as being anticipated by Woolley (6,234,856), the Examiner alleging inter alia that "the device of Woolley reads on the limitations of the claimed invention. Applicant disagrees. In addition, applicant claims prior inventorship.

The claims do not read on the Woolley device. Woolley discloses a towed water ski wherein the seat 50 for a rider's buttocks is mounted via an intermediate portion 48 on the upper surface of an elongate board 20, and a planing blade 38 is mounted on the lower end of a strut 36 depending from the underside of the elongate board 20. At low towing speeds, the elongate board rides on the water surface. At higher towing speeds, the planing blade raises the elongate board 20 above the water's surface. By suitable maneuvering, the rider can make the water ski jump out of the water; the rider and ski flying through the air as a projectile and no different than a fish will do; no aerodynamics are relied upon to keep the water ski airborne (inertia alone determining the air time).

The terms of applicant's claims are not met by Woolley's disclosure. Taking claim 21 as an example, the claim calls for a product inter alia having "a first section

constituting the wing of the product and deriving its lift in flight from forces resulting from its motion through air". The elongate board 20 hardly qualifies as a "wing". Moreover, there is no indication that the elongate board 20 provides "its lift in flight from forces resulting from its motion through air".

Independent claim 28 is not anticipated by Woolley either. Claim 28 requires inter alia a "board usable as a fuselage or tail section of a recreational product for skimming on water and flying the product derives its lift in flight from forces resulting from its motion through air aerodynamically and usable independently as a surfboard or ski", and "comprising a generally thin and flat elongated portion, a wider rear end on the elongated portion, and thin fins extending a) upwardly when the board is used as a ski and b) downwardly when the board is used as a surfboard and c) longitudinally from a surface of the wider rear end and [that] the thin fins are upwardly when the board is attached to the recreational product for aiding control when the product is in motion through air aerodynamically". Initially, it should be observed that Woolley's device is not shown as usable as a surf board. Nor are his longitudinally extending fins (195) extending "upwardly when the board is used as a ski", let alone "downwardly when the board is used as a surfboard". Nor are Woolley's thin fins "upwardly when the board is attached to the recreational product for aiding control when the product is in motion through air aerodynamically". The strained interpretation of Woolley does not anticipate applicant's claim 28.

Independent claim 34 is not anticipated by Woolley, either. Claim 34 requires device having a thin, wide body usable as an aerodynamically-supporting wing of a waterborne and airborne recreational vehicle and independently as a rideable element, comprising a central front end portion, a wide rearward portion, and a central rearward portion having a rearward facing opening for receiving an attachment rendering the body the wing of a recreational vehicle. Woolley does not have "a thin, wide body usable as an aerodynamically-supporting wing of a waterborne and airborne recreational vehicle and independently as a rideable element". Nor does he have "a rearward facing opening for receiving an attachment rendering the body the wing of a recreational vehicle".

Independent claim 38 is not anticipated by Woolley either. Claim 38 requires inter alia "a first section constituting the wing of the product when the board is attached to the recreational product and deriving its lift in flight from forces resulting from its motion through air and independently usable as a rideable element". Woolley's elongate board 20 hardly qualifies as a "wing". Moreover, there is no indication that his elongate board 20 provides "its lift in flight from forces resulting from its motion through air".

Claim 38 further requires "a second section constituting the fuselage or tail section of the product and independently usable as a surfboard or ski, the first section having longitudinally-extending control fins on its underside for withstanding rugged or slow turns in water and air". There is nothing in Woolley that is a second section constituting the fuselage or tail section of the product and independently usable as a surfboard or ski. Nor does his first section have longitudinally-extending control fins on its underside for withstanding rugged or slow turns in water and air.

Clearly, applicant's claims 21-32, 34-36, 38-42, and 44-51 are not anticipated by Woolley.

The rejection of claims 21-32, 34-36, 38-42, and 44-51 under 35 USC 102(e) as being anticipated by Woolley (6,234,856), is also improper because of applicant's earlier filing date. Applicant's application is a continuation-in-part of his earlier application, Ser. No. 09/313,566, filed 5/14/99 and disclosing the subject matter being claimed in the instant application as noted above. Woolley (6,234,856) is based on application Ser. No. 09/404,236 filed Sep. 23, 1999, a filing date over four (4) months later than applicant's. Clearly, applicant is entitled to a patent as his invention was "not described in ... (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent".

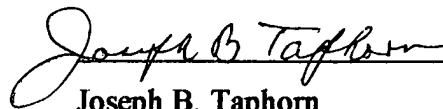
Claims 33 and 37 were rejected under 35 USC 103(a) as being unpatentable over Woolley in view of Saghri (5,498,184), the Examiner alleging that "Woolley reads on

most of the elements of the claimed device, except for an inflatable bladder". As observed above, claims on which claims 33 and 37 are dependent are not anticipated by the Woolley device and do not read thereon. Thus modification of the Woolley device to employ an inflatable bladder according to Saghri, will not result in the claimed device. It would not have been obvious to one having ordinary skill in the art, to use the inflatable material as taught by Saghri with the device of Woolley to create applicant's claimed device and to store it when deflated.

Applicant continues to believe that he is the first one to invent a rider recreational product having a wing section and a fuselage or tail section for skimming on water and flying through the air aerodynamically, that is separable into two sections comprising a first section constituting the wing of the product and deriving its lift in flight from forces resulting from its motion through air and independently usable as a rideable element, and a second section constituting the fuselage or tail section of the product and independently usable as a surfboard or ski. The claims reflect different aspects of the new invention.

Wherefore applicant believes that this application has been placed in condition for allowance, which favorable action at an early date is earnestly solicited.

Respectfully submitted,



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